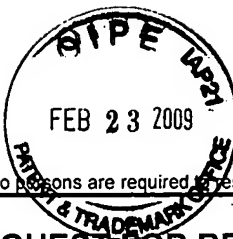


Doc Code: AP.PRE.REQ



PTO/SB/33 (01-09)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

07-1087

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on 02/19/2009

Signature

Typed or printed name Sarah M. Piccone

Application Number

10/777,586

Filed

02/12/2004

First Named Inventor

Roger Howard Williams III

Art Unit

3691

Examiner

Narayanswamy Subramanian

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.  
Registration number 35,402

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Steven I. Wallach

Typed or printed name

215-575-7000

Telephone number

02/19/2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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\*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. 07-1087

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* application of: Roger Howard WILLIAMS III

Serial No.: 10/777,586

Group No.: 3692

Filed: February 12, 2004

Examiner: Subramanian, Narayanswamy

For: SYSTEMS AND METHODS FOR IMPLEMENTING AN INTEREST-BEARING  
INSTRUMENT

**Mail Stop AF  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450**

**ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This Attachment addresses clear errors in the Examiner's rejections under 35 U.S.C.  
§§ 101 and 112.

Applicant and the undersigned wish to express their thanks to Examiners Kyle and  
Subramanian for permitting and participating in a telephonic interview today, rescheduling from a  
time set earlier this month. A summary of the substance of the interview is included in the  
following.

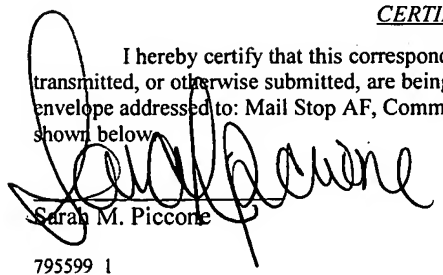
In the final Office action mailed August 19, 2008, the Examiner rejected all the pending  
claims – claims 105 and 107-111 – under §§ 101 and 112. During the interview the Examiner  
indicated that the § 101 rejection for claims 105 and 107-109 would be withdrawn in view of the  
intervening Federal Circuit decision in *In re Bilski*; the §101 rejection was maintained for  
claims 110 and 111. The § 112 rejections were maintained for all the claims.

For at least the following reasons, the remaining rejections are clearly erroneous and  
should therefore be reviewed before an appeal brief must be filed.

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shown below.

  
Sarah M. Piccone

Date: February 19, 2009

## **The Section 101 Rejection**

Independent claim 110 is directed by its preamble to “[a] medium storing instructions adapted to be executed by a computer processor.” Claim 111 depends from claim 110. During the interview, the Examiner asserted that, under *Bilski*, these claims could not be patent-eligible under § 101 because the specification did not sufficiently describe a storage medium.

Applicant is unaware that *Bilski* imports into the § 101 analysis this sort of sufficiency-of-disclosure concept, which essentially repeats the § 112 ¶ 1 rejection discussed below. But in any event the present application includes sufficient disclosure. The specification as filed explicitly discloses that the invention may be implemented on a personal or home computer, a commercial computer, or a mainframe computer. (Specification at p. 23, lines 17-29.) The specification further explains that “[a]s skilled artisans will appreciate, systems that may embody or may be used with the present invention may be implemented with a wide variety of processors, storage devices, and associated hardware and software.”

Given these explicit descriptions, those skilled in the art would certainly understand how the invention may be embodied in a medium storing instructions adapted to be executed by a computer processor. Therefore, to whatever extent that § 101 might require sufficient disclosure, the present application’s disclosure is more than sufficient. Given that, and given that claims 105 and 107-109 are patent-eligible, the § 101 rejection of claims 110 and 111 is clearly erroneous.

## **The Section 112 Rejections**

As alluded to above, the Examiner rejected claims 110 and 111 under § 112 ¶ 1 ostensibly because “there is no written description of any ‘medium storing instructions adapted to be executed by a computer processor’ in the specification as originally filed.” (Aug. 19, 2008 Office Action at 3.) But as described previously, the specification’s explicit descriptions of various

computers, processors, storage devices, and associated hardware and software are clearly sufficient to convey to skilled artisans that Applicant possessed at the filing date the subject matter of these claims. The § 112 ¶ 1 rejection of claims 110 and 111 is therefore clearly erroneous.

The Examiner rejected all the pending claims under § 112 ¶ 2 purportedly because “[i]t is not clear as to what [is] the outcome of [certain] steps” in the independent claims. (Aug. 19, 2008 Office Action at 3-4.) As an example, the Examiner points to the recitation in independent claim 105 regarding “processing in a computer processor data regarding providing that the instrument’s *sensitivity to parameter changes* incorporates” certain attributes, stating that “[i]t is not clear as to what happens when data regarding providing something is processed.” (Aug. 19, 2008 Office Action at 4.) But as the specification makes clear, the “providing” language simply describes in words an aspect of how the invention operates mathematically; data regarding that is thus clear to skilled artisans. Generally speaking, “[t]he invention permits a hitherto unquantified aspect of price behavior – *the embedded RPO [rate put option] and its consequent sensitivity to a changing interest rate regime* – to be made explicit, quantified, and used to correctly price instruments formerly deficient in this regard.” (Specification at p. 4, lines 28-30 (emphasis added).) The RPO is “provided” with the aid of mathematics. (See, e.g., specification at p. 17, line 5 to page 20, line 9.) For example, after describing a three-step process including Equations 8 and 9, the specification explains that as a result “an RPO, sold at inception to the creditor by the debtor, is exercised.” (Specification at p. 18, line 5.) Thus skilled artisans will readily find the claim language clear in light of the specification. Any doubt on this point is removed by the declaration of Dr. Arthur Maghakian, submitted with Applicant’s April 30, 2008 Amendment.

The Examiner also rejected dependent claims 107, 109, and 111 under § 112 ¶ 2 because supposedly it is not clear how the limitation “pricing and capturing the value of *the debtor’s or creditor’s regulatory capital savings*” further limits the applicable independent claims. (See Aug. 19, 2008 Office Action at 4.) But if each independent claim is considered, for sake of discussion, to include elements (a) to (f), each dependent claim simply adds an element (g). The quoted limitation is equivalent to “pricing and capturing the value of *a regulatory capital savings of the debtor or creditor.*” In each dependent claim, “regulatory capital savings” is a new claim term; a relationship or antecedent reference to any particular term in the applicable independent claim is not required to add a further limitation. Thus, dependent claims 107, 109, and 111 are clear to skilled artisans.

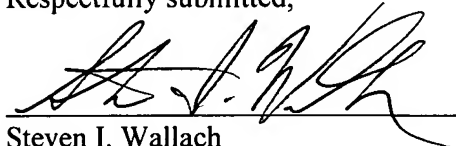
The § 112 ¶ 2 rejections of claims 105 and 107-111 are therefore clearly erroneous.

## Conclusion

For all the foregoing reasons, the request for a pre-appeal brief review should be granted.

If any fee is required, please charge Deposit Account No. 50-0979.

Respectfully submitted,



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Dated: February 19, 2009